| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/656,511 | 09/05/2003 | Joseph Peter Robert Tosey | 434300-490 | 8023 |

46188          7590          06/22/2010
Nixon Peabody LLP
P.O. Box 60610
Palo Alto, CA 94306

| EXAMINER |
|---|
| WHIPPLE, BRIAN P |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2452 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/22/2010 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>10 February 2010</u>.
2a) ☐ This action is **FINAL**.    2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1-62</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-62</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All  b) ☐ Some * c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1.      Claims 1-62 are pending in this application and presented for examination.

### *Continued Examination Under 37 CFR 1.114*

2.      A request for continued examination under 37 CFR 1.114, including the fee set forth

in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR

1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn

pursuant to 37 CFR 1.114. Applicant's submission filed on 2/10/10 has been entered.

### *Response to Arguments*

3.      Applicant's arguments filed 2/10/10 have been fully considered but they are not

persuasive.

4.      The applicant argues that amendments have been made to clarify actions are

occurring at a mail server, but the first limitation of claim 1 previously included language

related to receiving "at a mail server." Therefore, the limitation was previously rejected as

related to a mail server. Similarly, the second limitation of claim 1 claimed "storing the

information in a mail folder on the mail server." Therefore, such amendments to the first and

second limitations of the claim do not render the claim substantially different and the same

sections cited in the previous Office action may be relied upon to reject the amended

limitations.


5.      The applicant has amended language to include the mail server receiving a

synchronization request from the second client computing device and further defined the

final limitation of claim 1 to indicate the step is responsive to the synchronization request

and the forwarding is performed by a mail server.

        However, the applicant has failed to address the secondary art of Laves and has

merely contrasted the claim against Rigaldies. In response to applicant's arguments against

the references individually, one cannot show nonobviousness by attacking references

individually where the rejections are based on combinations of references. See *In re Keller*,

642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375

(Fed. Cir. 1986).

        Laves discloses the relevant amended subject matter, as a synchronization request is

sent to the server from a client and all other clients are synchronized by the server using the

relevant client folders (Col. 4, ln. 24-33, "server based synchronization session may be

employed to bring all the devices up to date"; Col. 7, ln. 54-65). The combination of Rigaldies

and Laves would result in a system in which a mail server synchronizes data across a

plurality of client devices.

## *Claim Rejections – 35 USC § 103*

6.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

7.      Claims 1-2, 5, 8-11, 14, 17-20, 23, 26-34, 37, 39-43, 46, 49-53, 56, and 59-62 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Rigaldies et al. (Rigaldies), U.S.

Patent No. 6,792,085 B1, in view of Laves, U.S. Patent No. 6,879,996 B1.

8.      As to claim 1, Rigaldies discloses a computer implemented method, comprising:

        by a mail server, receiving information from a first computing device regarding every

change made to an application database located on the first computing device (Abstract; Col.

4, ln. 29-35 and 41-60; Col. 22, ln. 21-23; the client, e-mail server and voice-mail all have

respective databases in the form of workstation mailbox, e-mail message store, and voice-

mail message store respectively; Fig. 6; Col. 13, ln. 43-60; Col. 15, ln. 44-58; Col. 19, ln. 40-

57; on-going synchronization occurs via the agent notifying the voice-mail server of any new

status of a message);

by the mail server, storing the information in a mail folder on the mail server, the

mail folder corresponding to a user associated with the first computing device and a second

computing device (Abstract; Fig. 1-4; Col. 10, ln. 1-8; Col. 15, ln. 59 – Col. 16, ln. 6; the

workstation mailbox is replicated/synchronized to the voice-mail server, the voice-mail

server inherently includes a mailbox representing the user to accomplish said

replication/synchronization) maintaining a copy of the application database (Abstract; Col. 4,

ln. 29-35 and 41-60; Col. 22, ln. 21-23; the client, e-mail server and voice-mail all have

respective databases in the form of workstation mailbox, e-mail message store, and voice-

mail message store respectively; Fig. 6; Col. 13, ln. 43-60; Col. 15, ln. 44-58; Col. 19, ln. 40-

57; on-going synchronization occurs via the agent notifying the voice-mail server of any new

status of a message); and

forwarding, by the mail server, the information from the mail folder to the second

computing device (Fig. 2; Col. 12, ln. 14-43).

Rigaldies is silent on the synchronization being done between the mail server and a

first and second *client* computing device;

by the mail server, receiving a synchronization request from the second client

computing device and

responsive to the synchronization request, forwarding the information.

However, Laves discloses synchronization (in a manner similar to that disclosed by

Rigaldies) between a mail server and a first and second *client* computing device (Abstract;

Col. 4, ln. 24-33);

by the mail server, receiving a synchronization request from the second client

computing device (Col. 4, ln. 24-33, "server based synchronization session may be employed

to bring all the devices up to date"; Col. 7, ln. 54-65) and

responsive to the synchronization request, forwarding the information (Col. 4, ln. 24-

33, "server based synchronization session may be employed to bring all the devices up to

date"; Col. 7, ln. 54-65).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Rigaldies in the aforementioned manner as taught by

Laves in order to bring two client devices up to date (Laves: Col. 4, ln. 24-33).


9.      As to claim 2, Rigaldies and Laves disclose the invention substantially as in parent

claim 1, wherein the information includes a record for each change made to the application

database since said last synchronization (Rigaldies: Col. 18, ln. 31-39; Col. 18, ln. 61 – Col.

19, ln. 23).

10.     As to claim 5, Rigaldies and Laves disclose the invention substantially as in parent

claim 2, wherein the record for each change includes an identification of the record

(Rigaldies : Col. 18, ln. 20-39; Col. 18, ln. 61 – Col. 19, ln. 23; Col. 19, ln. 40-57).


11.     As to claim 8, Rigaldies and Laves disclose the invention substantially as in parent

claim 1, further comprising:

        deleting the information from said mail folder after said forwarding (Rigaldies: Col.

18, ln. 31-39).


12.     As to claims 9, 18, 27, 29, 31, 33, 41, 51, and 60-62, the claims are rejected for reasons

similar to claim 1 above.


13.     As to claim 10, Rigaldies and Laves disclose the invention substantially as in parent

claim 9, wherein the uploading occurs in response to a request for synchronization on the

first client computing device (Rigaldies: Fig. 2).


14.     As to claim 11, Rigaldies and Laves disclose the invention substantially as in parent

claim 9, wherein the downloading occurs in response to a request for synchronization on the

second client computing device (Rigaldies: Col. 4, ln. 41-60; Col. 12, ln. 14-43).

15.     As to claims 14, 23, 37, 46, and 56, the claims are rejected for reasons similar to claim

5 above.


16.     As to claims 17, 26, 28, 30, 32, 39-40, 49-50, and 59, the claims are rejected for reasons

similar to claim 8 above.


17.     As to claims 19, 42, and 52, the claims are rejected for reasons similar to claim 10

above.


18.     As to claims 20, 43, and 53, the claims are rejected for reasons similar to claim 11

above.


19.     As to claim 34, the claim is rejected for reasons similar to claim 2 above.


20.     Claims 3, 12, 21, 35, 44, and 54 are rejected under 35 U.S.C. 103(a) as obvious over

Rigaldies and Laves as applied to claims 2, 9, 18, 34, 41, and 51 above, in view of Christie et

al. (Christie), U.S. Patent No. 5,757,669.

21.     As to claim 3, Rigaldies may be interpreted as inherently disclosing the record for

each change includes an identification of the computing device where the change took place

as discussed in reference to parent claim 2 (Col. 18, ln. 31-39; Col. 18, ln. 61 – Col. 19, ln. 23).

This is due to the fact that Rigaldies discloses synchronization between a single workstation

and a single mobile phone. As a consequence, the user must know that any status change

synchronization on one device is occurring to a change made by the other device (Abstract;

Col. 4, ln. 29-35 and 41-60). However, Rigaldies does not explicitly disclose that a record is

kept of the device identifiers related to changes.

        However, Christie does explicitly disclose the record for each change includes an

identification of the client computing device where the change took place (Col. 3, ln. 47-49).

Identification of a device responsible for changes in a networking environment is extremely

well known in the networking and database management arts. Networking and database

management rely heavily on the identification of devices responsible for actions, in order to

facilitate management and communication between devices.

        The benefit of identifying the device responsible for a change in Christie is facilitating

message forum communication (Col. 3, ln. 26-35). The entity responsible for the creation of a

message is vital in message forums.

        This benefit is also of use in Rigaldies' environment. Electronic mail and voice

messages are sent and received by a user. It is crucial that a record is kept by the identity of

message senders. Additionally, a benefit of device identity being stored would be that each

user computing device (the mobile phone and workstation) in Rigaldies' environment could

thus ensure that the end user is responsible for changes being made and that changes on

messages are not coming from a hostile outside user. Thus both network communication and

network security are benefits of identifying the creating entity in regards to electronic

messages.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Rigaldies and Laves by storing the identity of a user

computing device responsible for a change in a change record as taught by Christie in order

to facilitate network communications and network security as discussed above.


22.     As to claims 12, 21, 35, 44, and 54, the claims are rejected for reasons similar to claim

3 above.


23.     Claims 4, 6, 13, 15, 22, 24, 36, 38, 45, 47, 55, and 57 are rejected under 35 U.S.C.

103(a) as being unpatentable over Rigaldies and Laves as applied to claims 2, 9, 18, 34, 41,

and 51 above, in view of LaRue et al. (LaRue), U.S. Patent No. 6,449,622 B1.

24.     As to claim 4, Rigaldies and Laves disclose the invention substantially as in parent

claim 2, including a record for each change used to synchronize with the mail server

(Rigaldies: Col. 18, ln. 31-39; Col. 18, ln. 61 – Col. 19, ln. 23), but is silent on the record for

each change includes a time stamp indicating the time the record is synchronized with the

server.

        However, LaRue discloses the record for each change includes a time stamp indicating

the time the record is synchronized with the server (Col. 32, ln. 24-56).

        It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Rigaldies and Laves by recording a time stamp

indicating the last time a record was synchronized with a server as taught by LaRue in order

to compare change times between the server and the client in order to ensure that records

are not obsolete (LaRue: Col. 32, ln. 24-37).


25.     As to claims 6, 13, 15, 22, 24, 36, 38, 45, 47, 55, and 57, the claims are rejected for

reasons similar to claim 4 above.


26.     Claims 7, 16, 25, 48, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Rigaldies and Laves as applied to claims 2, 9, 18, 41, and 51, in view of Malik, U.S.

Publication No. 2002/0065892 A1.

27.     As to claim 7, Rigaldies and Laves disclose the invention substantially as in parent

claim 2, including a record for each change associated with a change-action-queue record

(Rigaldies: Col. 18, ln.  31-39; Col. 18, ln. 61 – Col. 19, ln. 23), but is silent on the record for

each change includes a location and identify of attachment documents.

        However, Malik discloses the record for each change includes a location and identify

of attachment documents ([0026] – [0028]).

        It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Rigaldies and Laves by including a location and identify

of attachment documents in a record as taught by Malik in order to minimize the amount of

duplicate copies of an identical attachment stored in a mail store (Malik: [0020]).


28.     As to claims 16, 25, 48, and 58, the claims are rejected for reasons similar to claim 7

above.


### *Conclusion*

29.     Any inquiry concerning this communication or earlier communications from the

examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-

1244.  The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Thu Nguyen can be reached on 571-272-6967. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information

for unpublished applications is available through Private PAIR only. For more information

about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free). If you would like assistance from a USPTO Customer Service Representative or

access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or

571-272-1000.

Brian P. Whipple
/B. P. W./
Examiner, Art Unit 2452
6/17/10


/THU NGUYEN/
Supervisory Patent Examiner, Art Unit 2452